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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,329	02/26/2004	Pascal Latreille	20513-00590-US1	1956

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EXAMINER

PALABRICA, RICARDO J

ART UNIT	PAPER NUMBER
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3663

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,329

Applicant(s)

LATREILLE ET AL.

Examiner

Rick Palabrica

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/25/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's 5/25/05 Amendment, which directly amends claims 15-19, amends the specification, and adds new claims 20-24, is acknowledged. This Amendment is in response to the 1/25/05 Office action.

2. Applicant traversed the rejection of claim 15 based on Martin ('038) or Martin et al. ('727), on the grounds that neither one of them: a) includes a means for introducing a means for carrying out work in the primary pipe; and b) has the means for carrying out work "is able to move along within the primary pipe from said first or second component to the new replacement section ..." The Examiner disagrees.

As to argument a), the above-cited feature upon which the applicant relies are not recited in rejected claim, as evidenced by the fact that the so-called "means for introducing the means" has been deleted in amended claim 15. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, if said unrecited feature is considered by the applicant to be critical to his invention, then such omission would amount to a gap between the essential elements. In this case, the claim(s) would be incomplete and would be rejected under 35 U.S.C. 112, second paragraph. See MPEP § 2172.01.

As to argument b), the above-cited feature upon which the applicant relies, i.e., ability to move along the pipe internal, is a statement of intended use, which does not

differentiate the claimed apparatus from the prior art, as indicated in section 5 of the previous Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All claims have limitation(s) that have insufficient antecedent basis/bases. For example, claim 15 recites the limitations, "the primary pipe", "the end parts of a new replacement section", "the primary pipe", "the replacement section", "the first and second components", etc. There are insufficient antecedent bases for these limitations in the claim because they are not recited as positive elements of the claimed apparatus. Note that these elements are part of the statement of intended or desired use in the claim preamble.

Dependent claims 16-24 are vague, indefinite and misdescriptive, and their metes and bounds cannot be determined, because their preambles recite the term "means" that are inconsistent with parent claim 15 that recites an "apparatus" and not a "means."

As to claim 17, there is no proper antecedent basis for "jack(s)."

As to claim 18, there is no proper antecedent bases for "the means for introducing the means for carrying out work into the pipe", "first or second components", "the component of the primary circuit communicating with the inner part of the primary pipe."

As to claim 19, there is no proper antecedent basis for "the interior of the primary pipe."

As to claim 20, there is no proper antecedent basis for "the first or second component."

As to claim 21, there is no proper antecedent basis for "the joined welded ends" and the remaining parts of the primary pipe."

As to claim 20, the term/phrase "rapid attachment device" is a relative term/phrase which renders the claim indefinite. The term "rapid" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 3663

4. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by either one of Martin (U.S. 4,847,038) or Martin et al. (U.S. 4,782,727).

The reasons are the same as those stated in section 5 of the 1/25/05 Office action, as further clarified in section 2 above.

The claim, which is directed to an apparatus and not to a process, is replete with statements of intended or desired use or method limitation, e.g., "after introduction through one of the first and second components of the primary circuit ...", "being able to move along the primary pipe ...", etc. As stated in section 5 of the previous Office action such statements do not serve to patentably distinguish the claimed structure over that of the reference, as long as the structure of the cited references is capable of being used in the same manner and for the same intended or desired use as the claimed invention. Either one of the cited reference has this capability, as discussed in section 2 above.

5. Claims 16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by either one of Martin or Martin et al.

The reasons for rejection are the same as those stated in section 6 of the 1/25/05 Office action, as further clarified in section 2 above. These claims are replete with statements of intended or desired use or method limitation that do not patentably distinguish the claims over the applied art, e.g., "for moving the support and the robot arm within the primary pipe", "providing a rotational drive to at least one wheel ..."

6. Claims 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by either one of Martin or Martin et al.

As to claim 20, Applicant traversed Martin and Martin et al. in the 5/25/05 Amendment on the grounds that, "the means for carrying out work in the primary pipe are not introduced through the reactor vessel or the primary pump. The Examiner disagrees. The limitation, "introduction through the reactor vessel or primary pump" is a method limitation that does not patentably distinguish the APPARATUS claims over the applied art.

As to claim 21, Applicant's claim language, "means to carry out at least one operation of machining, inspecting or welding" reads either on Martin's chamfering machine (see Fig. 17 or 18, and col. 10, lines 64+) or Martin et al.'s TIG welding machine (see col. 10, lines 28+). Either one of these machines is capable of carrying out at least one of the claimed operations of an inner part of the joined welded ends of a new replacement section and the remaining part of the pipe. Note that the limitation "the joined welding ends of the new replacement section and the remaining parts of the primary pipe" has no proper antecedent basis because it is part of the intended use of the claimed apparatus (see section 3 above).

7. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al.

As to claim 22, again the claim recites a limitation that is a statement of intended or desired use that does not patentably distinguish the claim over the applied art, i.e.,

"able to weld the end parts of the new replacement section to the ends of the remaining parts ...".

As to claim 23, absent a definition of the term, "rapid", Applicant's claim language "an end part bearing a rapid attachment device for automatic tools" reads on the end part of stem 84 (see Fig. 5). Note that the only positively recited element in the claim is "end part bearing a device". The rest of the recited elements are part of an intended use clause because the element, "device" is intended for the intended use of "rapid attachment of automatic tools."

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 571-272-6880. The examiner can normally be reached on 6:30-5:00, Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RJP
July 29, 2005


JACK KEITH
PRIMARY EXAMINER
SPE 3663